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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,948

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EXAMINER

VU, KIEU D

ART UNIT

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2175

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12/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/562,948	<b>Applicant(s)</b> TAKAKUWA ET AL.	
	<b>Examiner</b> KIEU D. VU	<b>Art Unit</b> 2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/02/08.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,14-17 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-12,14-17 and 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/02/08</u> .                                                | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action is responsive to the Amendment filed on 09/24/08.
2. The Terminal Disclaimer filed on 09/24/08 has been approved.

### ***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 3-8 are rejected under 35 U.S.C. 101 since the claimed invention is directed to non-statutory subject matter.

Regarding claim 1, the information as recited appears to be directed to non-functional descriptive materials. The claim fails to specify that the recorded information is a computer program. Furthermore, the claim fails to recite that the recording medium is structurally and functionally interconnected to the program in such a manner as to enable the program to act as a computer component and realize its functionality.

Claims 3-8 are rejected on the same rationale.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-12, 14-17, and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Setogawa, EP 0898279.

Regarding Claim 1, Setogawa discloses the claimed aspect of an information recording medium on which there are recorded (Abstract): Content information; button information for defining a button menu which allows an operation as for said content information (Setogawa, FIG. 3); and play list information for defining reproduction sequence of said content information by a unit of item (FIG. 3, Scene1, Scene2), which constitutes said content information and which is accessible upon reproduction, said button information including a plurality of button pages each of which can constitute the button menu and whose display can be changed to each other (Setogawa, FIG. 3, Scene1, Scene2, Next Page, Paragraph 0115, FIG. 10, FIG. 8, Fig 4), said button information being associated with button image information which is displayed and outputted with a background image (see Fig. 3-4), said play list information including i) item information for specifying each item which constitutes said content information (scene information); and ii) sub item information for specifying said button information as a sub item (Fig. 4), the item information including information indicating a reproduction time of the item, the sub item information including information indicating a reproduction time of the sub item ([0069], [0097]).

Regarding Claim 3, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa discloses the claimed aspect of at

least one of the plurality of button pages includes button command (FIG. 3, Scene1, Scene2, and Next Page) information for defining the operation.

Regarding Claim 4, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa discloses the claimed aspect of at least one of the plurality of button pages includes button control information being associated with at least one button image information which is displayed and outputted as the button menu (FIG. 3, Scene1, Scene2), and for displaying and outputting the button image information (FIG. 3, Scene1 is selected at step image displayed, at step 4 actual replay provided. (FIG. 3, Paragraph 0115).

Regarding Claim 5, most of the limitations have been met in the rejection of Claim 4. See details for Claim 4 rejection. Setogawa discloses the claimed aspect of button control information includes at least one of association information which indicates association with the button image information (FIG. 4, 11 is related to 15 (image) display position information which indicates a display position of a button defined by the button image information (FIG. 4, 15 (image) is related to 22 (Chapter1), and near-by button information which indicates a change in a state of the button caused by the operation, wherein the selection of BTN#1 changes the state of the button. (Setogawa, FIG. 4, Paragraphs 0084-0088).

Regarding Claim 6, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa discloses the claimed aspect of said button information is displayed, with it superimposed on or in place of one portion

of said content information(Setogawa, FIG. 3, 4, Scene1 and Scene2 are on the content information) or is not displayed at all, selectively in accordance with external designation.

Regarding Claim 7, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa discloses the claimed aspect of said button information is recorded together with said content information (FIG. 10, relationship between button information and content is illustrated), in a content space in which said content information is recorded and which occupies one area of a recording area in FIG. 3, 4, 6, 10, 20, wherein menu button is used for replaying information on the recording medium (Setogawa, Paragraphs 0001, 0003).

Regarding Claim 8, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa, discloses the claimed aspect of on which there is further recorded background image (FIG. 3, FIG. 4, background image, house) information for defining a background image on which the button menu is superimposed and displayed, wherein Scene1 selection is displayed on the background image.

Regarding Claim 9, the steps to achieve information recording medium achieves the information recording apparatus. The rejection for Claim 1 applies to Claim 9. See the rejection details for Claim 1.

Regarding Claim 10, most of the limitations have been met in the rejection of Claim 9. See details for Claim 9 rejection. The steps to achieve information recording

medium achieves the information recording apparatus. The rejection for Claim 6 applies to Claim 10. See the rejection details for Claim 6.

Regarding Claim 11, the rejection for Claims 1 and 9 apply to Claim 11. See rejection details for Claims 1 and 9.

Regarding Claim 12, Setogawa discloses an apparatus achieves the claimed aspect, the rejection for Claims 1 and 3 apply to Claim 12. See rejection details for Claims 1 and 3.

Regarding Claim 14, most of the limitations have been met in the rejection of Claim 12. See details for Claim 12 rejection. The rejection for Claim 5 applies to Claim 12. See rejection details for Claim 5.

Regarding claim 25, the rejection of claim 14 applies to claim 25.

Regarding Claim 15, most of the limitations have been met in the rejection of Claim 12. See details for Claim 12 rejection. The rejection for Claim 6 applies to Claim 15. See rejection details for Claim 6.

Regarding claim 26, the rejection of claim 15 applies to claim 26.

Regarding Claim 16, most of the limitations have been met in the rejection of Claim 12. See details for Claim 12 rejection. Setogawa discloses the claimed aspect of a buffer memory for storing the generated button menu in FIG. 13, wherein display memory 118 and 119 is illustrated. (Setogawa, Column 19, Paragraph 0119).

Regarding claim 27, the rejection of claim 16 applies to claim 27.

Regarding Claim 17, the rejection for Claims 1, 3, 4 apply to Claim 17. See the rejection details for Claims 1, 3 and 4.

7. Applicant's arguments filed 09/24/08 have been fully considered but they are not persuasive.

Applicant argues that Setogawa does not disclose "said button information includes a plurality of button pages each of which can constitute the button menu and whose display can be changed to each other". Examiner respectfully disagrees since Setogawa teaches navigating to the next page. Setogawa also teach plurality of button pages in Fig. 4 and paragraph [0084]-[0087].

Applicant argues that Setogawa does not teach that play list information includes item information for specifying each item which constitutes said content information and sub item information for specifying said button information as a sub item. Examiner respectfully disagrees since Figure 4 of Setogawa shows that playlist information includes picture 10 (content information) and buttons (button information).

Applicant argues "in SETOGAWA, the plurality of buttons (reference number 2 in Figure 3 of SETOGAWA) can be displayed on only one fixed background image and cannot be displayed on another background image". However, the claims do not recite that the buttons can be displayed on another background image. Although the claims are interpreted in light of the specification, limitations from the specification are not read



into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues "SETOGAWA only discloses the PGC (Program Chain) which specifies both of video pack (i.e., main picture) and sub-picture pack, and does not disclose "item information" for specifying item (i.e., content information) and "sub item information" for specifying sub item (i.e., button information) which are separately recorded." However, claim 1 does not recite that the content information and the button information are separately recorded. Applicant's attention is directed to claim 7 which recites "wherein said button information is recorded together with said content information." Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Please note that this application has been reassigned to examiner Kieu Vu.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4057.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore, can be reached at 571-272-4088.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

571-273-8300

and / or:

571-273-4057 (use this FAX #, only after approval by Examiner, for “INFORMAL” or “DRAFT” communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kieu D Vu/  
Primary Examiner, Art Unit 2175